

## **REMARKS**

Applicants respectfully request reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. No claims have been amended. Claim 21 has been canceled without prejudice. No claims have been added. Thus, claims 1-20 and 22 are pending.

Applicants further note that the currently amended claims only present combinations of limitations which have previously been presented for examination, and that no new matter has been added. Accordingly, Applicants respectfully submit that no new search is required

### **35 U.S.C. §101 Rejections**

The Office Action rejects claims 1-11 and 21 under 35 U.S.C. §101 as being directed toward non-statutory matter. More particularly, the Office Action alleges, *inter alia*, that the role allocation module and function allocation module in claim 1 do not fall within any of the four statutory categories of process, machine, manufacture or composition of matter. In order to advance the application to allowance, and without agreeing as to any characterizations made in the Final Office Action as a basis for rejecting the claims, Applicants cancel claim 21 herein without prejudice. With regard to pending claims 1-11, Applicants traverse the above rejection for at least the following reasons.

The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility ("Guidelines") are set forth in M.P.E.P. §2106. These Guidelines state, *inter alia*, that while abstract ideas, natural phenomena, and laws of nature are not themselves eligible for patenting, **methods and products employing** abstract ideas, natural phenomena, and laws of nature to perform a real-world function **may well be eligible for patenting**. See, e.g., M.P.E.P. §2106(IV)(C). As stated in M.P.E.P. §2106(IV)(C)(1) (emphasis added):

‘The conclusion that a particular claim includes a 35 U.S.C. 101 judicial exception **does not end the inquiry** because the **practical application of a**

**judicial exception** may qualify for patent protection. "**It is now commonplace** that an application of a law of nature or mathematical formula to a known structure or process **may well be deserving of patent protection.**" *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675.'

M.P.E.P. §2106(IV)(C)(2) states that for claims including excluded subject matter to be eligible for patent protection, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. M.P.E.P. §2106(IV)(C)(2) further states (emphasis added):

‘A claimed invention is directed to a **practical application of a 35 U.S.C. 101 judicial exception** when it:

- (A) "transforms" an article or physical object to a different state or thing;  
or
- (B) otherwise produces a useful, concrete and tangible result, based on the factors discussed below.’

Applicants respectfully submit that, at the very least, claim 1 transforms an article or physical object to a different state or thing by reciting in a salient portion:

“...a **memory to store the record** of the selection;...”

Therefore, even assuming *arguendo* that the role allocation module and function allocation module in claim 1 are non-statutory computer software or programs, which Applicants do not agree, claim 1 would nevertheless be directed to a practical application of a 35 U.S.C. §101 judicial exception by storing the claimed selection in a memory – thereby **transforming an article or physical object** to a different state or thing.

The *Response to Arguments* section of the Final Office Action does not contest that the memory recited in claim 1 transforms an article or physical object to a different state or thing. Rather, the Final Office Action alleges that claim 1 nevertheless does not meet the requirements of 35 U.S.C. §101 because, allegedly, the claimed role allocation module and function allocation module are still software modules and/or programs. However, such an interpretation of 35 U.S.C. §101 is **contrary** to the Guidelines, as indicated at least by the above-cited passages of M.P.E.P. §2106. As shown above, any allegedly non-statutory software modules and/or programs may be included in a claim, where, for example, said claim is also directed to transforming an article or physical object to a different state or thing.

For at least the foregoing reasons, claim 1 is directed to statutory subject matter under 35 U.S.C. §101, as are each of claims 2-11 by virtue of their claim dependency. Therefore, Applicants respectfully request that the 35 U.S.C. §101 rejection of pending claims 1-11 be withdrawn.

### 35 U.S.C. §103(a) Rejections

#### **35 U.S.C. §103(a) Rejection over *Owens*, *Sadhwani-Tully* and *Griffin***

The Office Action rejects claims 1-10 and 12-22 under 35 U.S.C. §103(a) as being obvious in light of *Owens et al.*, USPN 6,315,572 (hereinafter “*Owens*”) in view of *Sadhwani-Tully*, USPN 6,785,822 (hereinafter “*Sadhwani-Tully*”) and in further view of *Griffin et al.*, USPN 6,917,975 (hereinafter “*Griffin*”). To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by one or more prior art references. *See* M.P.E.P. § 2143.03. In order to advance the application to allowance, and without agreeing as to any characterizations made in the Final Office Action as a basis for rejecting the claims, Applicants cancel claim 21 herein without prejudice. With regard to pending claims 1-10, 12-20 and 22, Applicants traverse the above rejection for at least the following reasons.

Applicants respectfully submit that each of the above rejected claims is not obvious in light of *Owens*, *Sadhwani-Tully* and *Griffin*, based at least on the failure of the references to teach or suggest (emphasis added):

“...a **selection by a user** of at least one of an instructional design role and a content definition **role for the user to assume** with respect to the authoring tool;...a **first set of functions**, provided by the authoring tool and **selected by the user**...a **second set of functions**, also provided by the authoring tool and **selected by the user**...”

as variously recited in each of independent claims 1, 12 and 22. In rejecting the claims, the Final Office Action relies on a combination of *Owens* and *Sadhwani-Tully* which is alleged to teach or suggest modules by which **an administrator** allocates functions to roles of a user. However, as at least suggested by the Final Office Action itself, *Owens* and *Sadhwani-Tully* fail to teach or suggest, for example, (1) a **user selecting a role for that same user** to assume, (2) a first set of **functions selected by that same user** to be allocated to such a role, and (3) a second set of **functions selected by that same user** to

be allocated to another role. Instead, the claim rejection relies on *Griffin* as allegedly teaching or suggesting those limitations which are not taught or suggested by *Owens* and *Sadhwani-Tully* alone.

*Griffin* discusses a system administrator distributing an administrative task to another administrator by enabling a hierarchically inferior role of the other administrator to have a particular administrative capability. However, insofar as the system administrator in *Griffin* is merely delegating tasks away to a different hierarchically inferior administrator, *Griffin* **fails** to disclose, for example, either (1) an administrator selecting a role to be assumed by **that same administrator**, or (2) that same administrator selecting a function to be allocated to a role selected by **that same administrator** for that same administrator to assume. The Final Office Action seems to focus on the possibility that it may be an “administrative” capability which is given to a hierarchically inferior role of a user in *Griffin*. However, the particular functionality of any capability which may be given to a hierarchically inferior role in *Griffin* – e.g. an administrative functionality versus a non-administrative functionality – is **incidental** to whether or not such a role (or any capability to be given to such a role) is ever **selected by the same user** who assumes the role. In other words, regardless of whether or not *Griffin* and the claimed invention may both provide a user with access to the same type of functionality, which Applicants do not agree, *Griffin* nevertheless fails to teach or suggest that such a functionality is one which was selected by a user to be allocated to a role which was also selected by that same user for **that same user** to assume.

The mere possibility that a system administrator in *Griffin* allegedly assigns some kind of “administrative” capability to a hierarchically inferior role of another user, in and of itself, would **fail** to teach or suggest, for example, that **that user selected** the hierarchically inferior role to be assumed by **that same user**. Similarly, any alleged assigning by the **system administrator** of an “administrative” capability to a hierarchically inferior role of the other user, in and of itself, would **fail** to teach or suggest, for example, that **that user selected** that capability to be allocated to the hierarchically inferior role. Even assuming *arguendo* that all other claim limitations are taught or suggested by the cited references, which Applicants do not agree, *Griffin* fails to

teach or suggest (1) a user selecting a role for that same user to assume, (2) a first set of functions selected by that same user to be allocated to said user-selected role, and (3) a second set of functions selected by that same user to be allocated to another such user-selected role.

Accordingly, each of independent claims 1, 12, and 22 is non-obvious in light of *Owens*, *Sadhwani-Tully* and *Griffin*. If an independent claim is non-obvious under 35 U.S.C. §103, then any claims depending therefrom – e.g. claims 2-10, 13-20 and 22 – are also non-obvious. See M.P.E.P. §2143.03. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §103(a) rejection of claims 1-10 and 12-20 and 22 based on *Owens*, *Sadhwani-Tully* and *Griffin* be withdrawn.

### **35 U.S.C. §103(a) Rejections**

#### **35 U.S.C. §103(a) Rejection over *Owens*, *Sadhwani-Tully*, *Griffin* and *Boon***

The Office Action rejects claim 11 under 35 U.S.C. §103(a) as being obvious in light of *Owens et al.*, USPN 6,315,572 (hereinafter “*Owens*”) in view of *Sadhwani-Tully*, USPN 6,785,822 (hereinafter “*Sadhwani-Tully*”) and in further view of *Griffin et al.*, USPN 6,917,975 (hereinafter “*Griffin*”) and in further view of *Boon*, USPN 2004/0219494 (hereinafter “*Boon*”). In rejecting claim 11, the Final Office Action relies at least in part on the previously-discussed 35 U.S.C. §103 rejection of claim 1. *Boon* is further alleged to teach or suggest a set-up wizard. For at least the following reasons, Applicants traverse the above rejection.

As discussed above, there is at least one limitation of claim 1 which is neither taught nor suggested by any combination of *Owens*, *Sadhwani-Tully* and *Griffin* – e.g. (1) **a user selecting a role for that same user** to assume, (2) a first set of **functions selected by that same user** to be allocated to such a role, and (3) a second set of **functions selected by that same user** to be allocated to another role. The Final Office Action does not offer *Boon* as teaching or suggesting those limitations of claim 1 which are non-obvious in light of *Owens*, *Sadhwani-Tully* and *Griffin* alone. Applicants respectfully submit that no combination of *Owens*, *Sadhwani-Tully*, *Griffin* and *Boon* teaches or suggests (1) a user selecting a role for that same user to assume, (2) a first set of functions

selected by that same user to be allocated to such a role, and (3) a second set of functions selected by that same user to be allocated to another role.

Therefore, the cited references fail to either teach or suggest at least one limitation of the invention as variously recited in independent claim 1. Accordingly, independent claim 1 is non-obvious in light of *Owens*, *Sadhwani-Tully*, *Griffin* and *Boon*, as is claim 11 by virtue of its claim dependency. See M.P.E.P. §2143.03. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §103(a) rejection of claim 11 based on *Owens*, *Sadhwani-Tully*, *Griffin* and *Boon* be withdrawn.

### **Finality of the Final Office Action**

The above-discussed 35 U.S.C. §103 rejections each rely at least in part on an assertion that *Griffin* fails to teach or suggest claim limitations which are not taught or suggested by *Owens* and *Sadhwani-Tully* – e.g. (1) a **user selecting a role for that same user** to assume, (2) a first set of **functions selected by that same user** to be allocated to such a role, and (3) a second set of **functions selected by that same user** to be allocated to another role. However, as discussed above, there is no apparent teaching or suggestion, in either the relied upon passages or elsewhere in of *Griffin*, of either (1) a selection by a user of a role to be assumed by that same user, or (2) a selection by that same user of a function to be allocated to a role which that same user has selected for that same user to assume. Therefore, there is no apparent pertinence of *Griffin* to those claim limitations which are not taught or suggested by *Owens* and *Sadhwani-Tully* alone. Nor does the Final Office Action **explain** any supposed pertinence of the relied-upon portions of *Griffin* with respect to the claim limitations they are purported to render obvious. As stated in M.P.E.P. §706 and 37 C.F.R. §1.104 (emphasis added):

“When a reference is complex or shows or **describes inventions other than that claimed** by the applicant, the particular part relied on must be **designated as nearly as practicable**. The pertinence of each reference, if not apparent, **must be clearly explained** and each rejected claim specified.”

Applicants respectfully submit that, in the absence of any apparent pertinence of *Griffin* with respect to the claim limitations in question, the failure of the Final Office Action to provide a clear explanation of any such pertinence of *Griffin* is a failure to meet the requirements for proper claim examination set forth in M.P.E.P. §706 and 37 C.F.R.

§1.104. Accordingly, the Final Office Action **improperly** sets forth a **final** rejection of the above claims which denies Applicants any opportunity to respond to a clearly explained basis for claim rejection. For at least the foregoing reasons, Applicants respectfully request that the finality of the Final Office Action be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1-20 and 22 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
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